

REMARKS

Formalities

Claims 1-29 are in the case. Claims 1, 13, 14, 18-20 and 22-27 are amended herein. Applicants note that the Examiner has renumbered incorrectly numbered claims 12-29, and thus Applicants have not indicated the renumbering as amendments herein. Applicants have, however, amended claims 13, 18-20 and 23-27 for correct dependency.

The Examiner has objected to claim 25, stating that "'ductile polymer', as stated in claim 25, has not been described in the specification." Applicants respectfully note that ductile polymers are described at paragraph [0043] of Applicants' specification, and ask that this objection be withdrawn.

The Examiner has objected to claims 1, 14 and 25 due to various minor informalities. It is believed that the Examiner's reference to claim 25 in this objection actually pertains to claim 22 or claim 27. Applicants have amended the claims pursuant to the Examiner's suggestions.

The Claimed Invention

In general, Applicants' invention features digital thermometers for measuring the temperature of a living being by inserting a portion of the thermometer in the mouth of the living being. The thermometers include, *inter alia*, a probe with first and second ends and an intermediate portion of the probe disposed between the first and second ends. In one aspect of Applicants' invention, recited in claim 1, the intermediate portion has a non-linear shape. In another aspect, recited in claim 22, the intermediate portion of the probe is configured to be bent into a desired non-linear shape, e.g., by a caregiver or the patient. As a result, the probe can be shaped to fit any size mouth, from infant to adult, and can also be readily used to measure underarm or rectal temperature.

The Rejections

Independent claim 1 has been rejected as unpatentable over Babkes in view of JP 61270631 ("JP") or Haberl or Eagan. Independent claim 22 has been rejected as unpatentable

over Babkes in view of Haberl or Eagan. Dependent claims 2-11, 16-17, 20-21 and 23-27 have been rejected as unpatentable over these combinations of references. Dependent claims 14, 15 and 18-19 have been rejected as unpatentable over these references further combined with Zaragoza (claim 14), Saccardo (claim 15) and Haghkar (claims 18-19).

Applicants will discuss these rejections in turn.

Claim 1 is patentable over Babkes in view of JP or Haberl or Eagan

The Examiner acknowledges that the probe of the Babkes thermometer does not include an intermediate portion having a non-linear shape, citing JP, Haberl and Eagan to remedy this deficiency. The Examiner asserts that “it would have been obvious ... to modify the shape of the probe disclosed by Babkes, so as to have a curved intermediate portion, as taught by [JP, Haberl or Eagan], in order to allow the user to position the probe onto a patient’s upper lip to perform a stable, easy and accurate thermometry without making significant accommodations.”

The Examiner has not established *prima facie* obviousness, as the motivation asserted by the Examiner is not found anywhere in the art of record. In particular, there is nothing in JP, Haberl or Eagan that would have remotely suggested to the artisan the desirability of “allow[ing] the user to position the probe onto a patient’s upper lip to perform a stable, easy and accurate thermometry without making significant accommodations.” Instead, this motivation is found only in *Applicants’ own disclosure*.

It is axiomatic that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some *teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art*. (See MPEP, §2143.01. Emphasis added.) Motivation cannot come from the invention itself. (See, e.g., Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc., 21 F.3d 1068, 1072 (Fed. Cir. 1993). If the Examiner chooses to maintain the rejections, it is respectfully requested that the Examiner point out where in the cited art the alleged motivation to modify the Babkes thermometer is found.

Moreover, Applicants respectfully submit that the artisan would not have looked to JP, Haberl or Eagan for guidance in modifying the medical thermometer described by Babkes. JP describes a probe for measuring signals input/output to a semiconductor device. Haberl describes a flexible hose or tube used for conveying fluids to a desired location. Eagan describes an electronic instrument having an acoustic transducer microphone located at the end of a probe arm for locating sounds in an engine. There are two criteria for determining whether a reference is analogous, and thus whether that reference can be combined with other references to establish *prima facie* obviousness: (1) whether the prior art is from the inventor's field of endeavor, and (2) if it is not from the same field of endeavor, whether the reference is reasonably pertinent to the problem to be solved. See, e.g., In re Clay, 966 F.2d 656, 658-659 (Fed. Cir. 1992). In this case, the secondary references are clearly not from the same field of endeavor (thermometers) as the Babke reference. Thus, the issue is whether the secondary references are "reasonably pertinent to the problem to be solved." As the court explained in In re Clay,

a reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem. Thus, the purposes of both the invention and the prior art are important in determining whether the reference is reasonably pertinent to the problem the invention attempts to solve. If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection. An inventor may well have been motivated to consider the reference when making his invention. If it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it. (*Id.*)

A person having ordinary skill in the art would not reasonably have expected to solve the problems of medical thermometers, e.g., that such thermometers are uncomfortable to the patient and often inaccurate due to movement within the patient's mouth (see Applicant's specification, paragraphs [003]-[006], by considering references dealing with measurement of electrical signals from semiconductor devices (JP), or acoustical signals from engines (Eagan), much less conveyance of fluids through tubes (Haberl). Thus, these references are not reasonably pertinent to the problem to be solved, and cannot properly form a basis for *prima facie* obviousness.

Claim 22 is patentable over Babkes in view of Haberl or Eagan

Claim 22 is patentable for at least the reasons discussed above. The art of record provides no motivation to modify the thermometer described by Babkes to include a probe having an intermediate portion that is configured to be bent into a desired non-linear shape. Nor would the artisan have looked to Haberl or Eagan for guidance in modifying the medical thermometers described by Babkes, as discussed above.

Applicants dependent claims are patentable over the art of record

Applicants' dependent claims are patentable for at least the reasons discussed above. Zaragoza, Saccardo and Haghkar do not supply a motivation to modify Babkes as proposed by the Examiner.

Conclusion

Enclosed is a \$225 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050, referencing Attorney Docket No. 12966-005001.

Respectfully submitted,

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